



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,004	10/18/2000	Leonard Forbes	303.324US4	4509

7590 03/26/2002

Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O.Box 2938
Minneapolis, MN 55402

EXAMINER

MONDT, JOHANNES P

ART UNIT	PAPER NUMBER
----------	--------------

2826

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,004

Applicant(s)

FORBES ET AL.

Examiner

Johannes P Mondt

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 36-100 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of the Preliminary Amendment filed 10/18/00, in which claims 1-35 have been canceled, is acknowledged. Therefore, claims 1-35 have been withdrawn from consideration. The Preliminary Amendment has been entered as Paper No. 3.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 36-45, 56-67, 68-85, and 98-100, drawn to a field effect transistor with wide band gap (> 1.5 eV) semiconductor material, specifically silicon carbide, as a part of the device, classified in class 257, subclass 77;
 - II. Claims 46-51, drawn to a light-responsive field effect transistor, classified in class 257, subclass 225;
 - III. Claims 52-55 and 86-97, drawn to a semiconductor memory device with floating gate electrode, classified in class 257, subclass 315.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product made and use of product. The inventions are distinct if either or both of the following can be shown: (1) that the product made claimed can be used for a different purpose, or (2) that the use of the product as claimed can be different from the one specified in the relevant claims (MPEP §806.05(f)). In the instant case, unpatentability of the Group I invention would not necessarily imply unpatentability of the Group II invention, because wide band

Art Unit: 2826

semiconductor materials exist, other than silicon carbide, and could be used for the purpose delineated in claims 46-51.

Similarly, inventions I and III are related as product made and use of product. The inventions are distinct if either or both of the following can be shown: (1) that the product made claimed can be used for a different purpose, or (2) that the use of the product as claimed can be different from the one specified in the relevant claims (MPEP §806.05(f)). In the instant case, unpatentability of the Group I invention would not necessarily imply unpatentability of the Group II invention, because wide band semiconductor materials exist, other than silicon carbide, and could be used for the purpose delineated in claims 52-55 and 86-97.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the fields of search are not co-extensive and separate examination would be required, restriction for examination purposes as indicated is proper.


4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 FR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt, whose telephone number is (703) 306-0531. The examiner can normally be reached on Monday-Friday 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (703) 308-6601. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JPM
January 4, 2002



Matthew J. Flynn
Primary Examiner